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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

059643.00588

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Application Number:

10/528,018

Filed: May 12, 2005

First Named Inventor:

Markus WARSTA et al.

Art Unit: 2617

Examiner: Willie J. Daniel, Jr.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

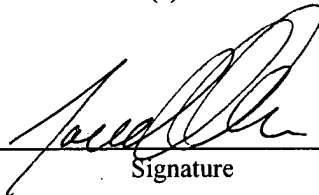
Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

☒ Attorney or agent of record.
Registration No. 61,058

☐ Attorney or agent acting under 37 CFR 1.34.
Registration Number if acting under 37 CFR 1.34 _____



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January 16, 2009

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.

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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Markus WARSTA et al.

Art Unit: 2617

Application No.: 10/528,018

Examiner: Willie J. Daniel, Jr.

Filed: May 12, 2005

Attorney Dkt. No.: 059643.00588

For: METHOD AND APPARATUS FOR STORING SUBSCRIBER DATA

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 16, 2009

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-8, 10-13, 15 and 17-41 in the above identified application. Claims 1-8, 10-13, 15 and 17-41 were finally rejected in the Office Action dated October 16, 2008. Applicants filed a Response to the Final Office Action on November 17, 2008, and the Office issued an Advisory Action dated December 9, 2008, maintaining the final rejections of claims 1-8, 10-13, 15 and 17-41. Applicants hereby appeal these rejections due to clear errors contained therein and submit this Pre-Appeal Brief Request for Review.

As a matter of course, Applicant respectfully points out that the finality of the Office Action issued on October 16, 2008, was improper because the Office Action failed to respond to any of Applicants traversals in the Response filed on June 27, 2008.

MPEP § 707.07(f) states that “[i]n order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner **must** provide clear explanations of all actions taken by the examiner during prosecution of an application” (emphasis added). “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it” (*Id.*). “The examiner must address all arguments which have not already been responded to in the statement of the rejection” (MPEP § 707.07(f), Examiner Note 1).

On pages 24-25 of the Response filed on June 27, 2008, Applicant traversed the rejection of claims 1, 19, 22, and 32 by arguing that Boivin fails to disclose a processor configured to update routing information. Additionally, Applicant traversed the rejection of claims 19-20, 23, and 41 by arguing that Boivin fails to disclose the provisioning of an active subscriber register.

Furthermore, Applicant traversed the rejection of claims 6-9 on the grounds that a combination of Boivin and Kowarsch fails to disclose all the limitations recited therein.

However, the Office Action of October 16, 2008, failed to address any of Applicant's traversals. On page 11, the Office Action alleged that the traversals were moot because a new grounds for rejection was necessitated by the amendments presented in the previous Response. However, a comparison of the Office Action issued on March 31, 2008, and the Office Action issued on October 16, 2008, clearly shows that many claims were rejected on the same grounds and in the same manner. For example, both Office Actions rejected claims 1-5 and 10-13 under 35 U.S.C. § 102(e) as being anticipated by Boivin, and both sets of rejections cited to the same portions of Boivin. In short, the rejections of at least claims 1-5 and 10-13 are practically identical in both Office Actions. Consequently, finality of the Office Action issued on October 16, 2008, was made in clear error because the Office Action failed to respond to any of Applicant's traversals in the Response filed on June 27, 2008.

Claims 1-5, 10-13, 15, 19-25, 28-29, 32-36, and 39-41 were rejected under 35 U.S.C. § 102(e) as being anticipated by Boivin (U.S. Patent Publication No. 2003/0092436). However, as discussed below, Boivin fails to disclose or suggest all the limitations of the rejected claims. Accordingly, the Office Action committed a clear error in maintaining this rejection.

Boivin discloses a system and method for reuse of a terminating telephone number with multiple mobile telephones. In Boivin, a customer places a first call on a recently activated disposable/recyclable cell phone (RDP) 214, and a mobile switching center (MSC) 208 connects the call to a PSP 202, based on a mobile identification number (MIN) of the RDP. The prepared server platform (PSP) 202 connects the call to a server 218 configured to use the MIN to determine whether the RDP 214 is newly activated. In scenarios where the RDP 214 is newly activated, the server 218 connects the call to an interactive voice response (IVR) unit 222 that prompts the user indicate whether the user is a new user of RDPs. If the user is a new user, then the default phone number is retained and the call is completed. However, if the user is a returning user, then the IVR unit 222 prompts the user to indicate whether the user would like to use a new phone number for the new RDP or reuse a phone number of a previous RDP. If the user wishes to reuse a previous phone number, then the IVR unit 222 prompts the user to enter the previously used phone number, and the server 218 communicates with a database 220 to determine whether the entered phone number is currently inactive and available for use. If the phone number is available, then it is assigned to the RDP 214. However, if the phone number is unavailable, then the RDP 214 is assigned the default phone number. Consequently, the communication system of Boivin operates based on MINs and previously used telephone numbers.

However, Boivin fails to disclose or suggest all the limitations of the rejected claims. For example, Boivin fails to disclose or suggest "routing said message from said routing register to an inactive subscriber register for storing subscriber data for inactive subscribers," as recited in claim 1, and as similarly recited in claims 19, 21-22, and 32. The failure of Boirin to disclose or suggest these limitations constitutes clear error which warrants withdrawal of this rejection.

The Office Action took the position that these features are disclosed by Boivin in Figures 2-3 and paragraphs [0018]-[0020], [0025]-[0026]. However, these portions of Boivin do not disclose the foregoing limitations. Figure 2 of Boivin depicts a block diagram of a mobile communication network, and Figure 3 of Boivin depicts a process for reusing a phone number of an RDP 214. Paragraphs [0018]-[0020] of Boivin discuss a visitor location register (VLR) 118 that is updated with information of the mobile phones within its service area, a home location register (HLR) that stores management data relating to the mobile phones that correspond thereto, and a service control point (SCP) that provides routing data needed for advanced network services.

Further, paragraphs [0025]-[0026] of Boivin discuss a customer that places a first call on a recently activated RDP 214, and a MSC 208 that connects the call to a PSP 202, based on a MIN of the RDP. The PSP 202 connects the call to a server 218, and the server 218 uses the MIN to determine whether the RDP 214 is newly activated. Accordingly, while these portions of Boivin appear to disclose subject matter pertinent to reusing a previous phone number, these portions of Boivin do not disclose or suggest, “a routing register,” “an inactive subscriber register,” or “routing said message from said routing register to an inactive subscriber register,” as recited in claims 1, 19, 21-22, and 32.

Additionally, Boivin fails to disclose or suggest “updating said routing information associated with the subscriber at the routing register to route subsequent signaling associated with the subscriber to an active subscriber register,” as recited in claim 1, and as similarly recited in claims 19, 21-22, and 32.

The Office Action took the position that these limitations are disclosed by Boivin in Figure 3 and paragraphs [0019]-[0020], [0028], and [0030]. However, these portions of Boivin fail to disclose or suggest all the features of the claimed “updating.” As mentioned above, paragraphs [0019]-[0020] discuss a VLR, an HLR and a SCP. Paragraphs [0028] and [0030] discuss operations for reusing a previous phone number, presented in Figure 3 of Boivin. However, these portions of Boivin do not disclose, “updating said routing information associated with the subscriber at the routing register to route subsequent signaling associated with the subscriber to an active subscriber register.” Indeed, these portions of Boivin fail to even disclose “a routing register” and “an active subscriber register,” as recited in the rejected claims.

Furthermore, Boivin fails to disclose or suggest “a processor configured to provision the active subscriber register of the communication network with subscriber data associated with the inactive subscriber to be activated based on the received message,” as recited in claim 19, and as similarly recited in claims 20, 23, and 41, though each claim has its own scope.

The Office Action took the position that these features are disclosed by Boivin in paragraphs [0019]-[0020] and [0030]. As discussed above, paragraphs [0019]-[0020] of Boivin discuss a VLR 118 that is updated with information of the mobile phones within its service area, a HLR that stores management data relating to the mobile phones that correspond thereto, and a SCP that provides routing data needed for advanced network services. Also as discussed above, paragraph [0030] of Boivin discloses operations for reusing a previous phone number, presented in Figure 3 of Boivin.

Accordingly, these portions of Boivin do not disclose or suggest any subject matter that amounts to “a processor configured to provision the active subscriber register of the communication network with subscriber data associated with the inactive subscriber to be activated based on the received message,” as recited in the claims.

In light of the above, Boivin fails to disclose or suggest all the limitations of claims 1, 19-23, 32, and 41. Similarly, Boivin fails to disclose or suggest all the limitations of claims 2-5, 10-13, 15, 24-25, 28-29, 33-36, and 39-40, for their dependency from claims 1, 20, and 32, and for the patentable subject recited therein. Consequently, the Office Action made a clear error by rejecting claims 1-5, 10-13, 15, 19-25, 28, 29, 32-36, and 39-41 under 35 U.S.C. § 102(e) as being anticipated by Boivin.

Claims 6-8, 26-27, 30-31, and 37-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boivin in view of Kowarsch (U.S. Publication No. 2004/0132449). The Office Action took the position that Boivin fails to disclose all the limitations of the rejected claims. However, the Office Action also took the position that Kowarsch accounts for the deficiencies of Boivin in a manner that renders the rejected claims obvious. The Office Action committed a clear error in rejecting these claims under 35 U.S.C. § 103(a).

Kowarsch discloses a method and apparatus for permitting a mobile station to operate in a visited network. This is achieved by monitoring an attempt by the mobile station to sign onto a visited network, determining whether a predetermined condition is met, and automatically initiating the creation of an account for the mobile station in the visited network.

However, a combination of Boivin and Kowarsch fails to disclose or suggest all the limitations of the rejected claims. For example, a combination of Boivin and Kowarsch fails to disclose or suggest the limitations discussed above regarding the “routing” and “updating,” as recited in claims 1 and 32, from which claims 6-8 and 37-38 depend. Similarly, a combination of Boivin and Kowarsch fails to disclose or suggest the limitations discussed above regarding the “processor configured to provision,” as recited in claim 20, from which claims 26-27 and 30-31 depend.

As discussed above, Boivin fails to disclose or suggest the foregoing limitations. Similarly, Kowarsch fails to cure the deficiencies of Boivin. Instead, Kowarsch discloses a method and apparatus for permitting a mobile station to operate in a visited network, without discussing the “routing” and “updating” of claims 1 and 32, or the “processor” of claim 20. Consequently, this rejection has been made in clear error for at least the reason that a combination of Boivin and Kowarsch fails to disclose or suggest all the limitations of claims 6-8, 26-27, 30-31, and 37-38, for their dependency from claims 1, 20, and 32, and for the patentable subject matter recited therein.

Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Boivin in view of Coad (U.S. Publication No. 2003/0190913 Coad). The Office Action took the position that Boivin fails to disclose all the limitations of the rejected claims. However, the Office Action also took the position that Coad remedies the deficiencies of Boivin in a manner

that renders the rejected claims obvious. Applicant respectfully asserts that the Office Action committed a clear error in rejecting these claims under 35 U.S.C. § 103(a).

Boivin is discussed above. Coad discloses a solution for enabling a mobile user to make a call by using a pre-paid account that is automatically set up by a visited network. In Coad, an auxiliary HLR recognizes that the user would normally be denied service and, or receipt of a registration request, sets up an account, which is made active in a final stage after notification to the user in a Short Message and payment of funds.

However, a combination of Coad and Boivin fails to disclose or suggest all the limitations of claims 17-18. For example, a combination of Coad and Boivin fails to disclose or suggest the "routing" and "updating" of claim 1, from which claims 17-18 depend. As detailed above, Boivin fails to disclose these limitations. Similarly, Coad fails to disclose these limitations. Instead, Coad discusses a communication system where pre-paid cell phone may make calls in a visited network, without disclosing the foregoing limitations. Accordingly, a combination of Boivin and Coad fails to disclose or suggest the limitations of claims 17-18, for their dependency from claim 1, and for the patentable subject matter recited therein. Therefore, the Office Action committed a clear error in rejecting these claims under 35 U.S.C. § 103(a).

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form
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